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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,547	01/29/2001	Carmel Sofer	P-2351-US	6106

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Sol Sheinbein
GE Ehrlich (1995) Ltd
Anthony Castorina
2001 Jefferson Davis Highway Suite 207
Arlington, VA 22202

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,547

Applicant(s)

SOFER ET AL.

Examiner

Joy K Contee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 12-19 is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 6-10, filed February 5, 2004 have been fully considered but they are not persuasive.

Regarding claim 6, in response to applicant's argument that the references fail to show certain features of applicant's invention (see page 13 of *Remarks*), it is noted that the features upon which applicant relies (i.e., controlling call duration on the basis of the user's current balance) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Kari's (6480485) invention incorporates a BGGSN which allows for exchanging of "charging information" to the operator's charging center, which reads on prepaid users since "charging information" is relevant in "prepaid" scenario and a period (e.g., monthly) based billed subscriber, which do not pay in advance.

Regarding claims 7 and 9, Applicant argues specifically that Kari does not disclose wherein said call management information is directed to said home intelligent gateway by said home mobile network. Examiner disagrees. Kari discloses that the SGSN in the network controlled by operator 1 may send charging information to the BGGSN of the same network, when the subscriber's home network is the network of the operation 1 (col. 5, line 65 to col. 6, line 5).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kari.

Regarding claim 6, Kari discloses a method for registering a user subscribing to a home mobile network and roaming in a visited mobile network said home mobile network having a home intelligent gateway integrated therein that is connected to a global packet switch network, said home mobile network being configured to direct signaling messages associated with roaming prepaid users to said home intelligent gateway, the method comprising the step of :

inherently registering (i.e., for roaming subscribers in the basic structure of GSM network, registration is required) said user at said visited mobile network if (i.e., the inter-operator backbone network is required to support GPRS roaming between different GPRS networks, see col. 4, lines 24-45) said visited mobile network has a visited intelligent gateway integrated therein that is connected to said global packet switch network (col. 3, lines 25-65), by communicating call management information (i.e., reads on user-related charging for traffic fees of specific period of time) for controlling a duration of calls associated with said user at said visited mobile network over said global packet switch network.

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Kari does not explicitly recite refusing to register said user if said visited mobile network does not have a visited intelligent gateway integrated therein that is connected to said global packet switch network.

However, at the time of the invention it would have been obvious to one of ordinary skill in the art that a GPRS roaming subscriber would be denied registration in a visited mobile network if some form of intelligent gateway (e.g., inter-operator backbone couple to BGGSN) is not present to facilitate communication between different GPRS networks as suggested in Kari (col. 4, lines 26-45).

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kari, in view of Kirby, U.S. Patent No. 6,047,179.

Regarding claim 11, Kari is analogous to the method for registering a user subscribing to a home mobile network and roaming in a visited mobile network according to claim 6. Kari fails to disclose wherein said control information comprises an allowed call duration.

In a similar field of endeavor, Kirby discloses wherein said control information comprises an allowed call duration (i.e., reads on authorization period) (col. 21, line 55 to col. 22, line 28).

At the time of invention it would have been obvious to one of ordinary skill in the art to modify Kari to include a predetermined time for allowed communication when roaming in a visited network for the purpose of allowing prepaid account services.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby, in view of Kari.

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Regarding claims 7 and 9, Kirby discloses the method for enabling telephony services when roaming in a visited mobile network to a user subscribing to a home mobile network and having a prepaid account with a balance at said home mobile network, the method comprising the steps of:

registering said user in said visited mobile network (col. 11, lines 51-58).

Kirby fails to teach placing mobile originated (or terminated) calls from said visited mobile network if said visited mobile network has a visited intelligent gateway integrated therein that is connected to said global packet switch network.

In a similar field of endeavor, Kari discloses placing mobile originated (or terminated) calls from said visited mobile network if said visited mobile network is connected to an inter-operator backbone network (col. 4, lines 24-28).and an internal backbone network of the packet radio network including a billing gateway GPRS support node (BGGSN), wherein gateway GPRS support nodes of different operators may communicate with one another regarding billing matters (col. 5, lines 18-30), i.e., home intelligent gateway integrated into said home mobile network communicates call management information for controlling a duration of said call via a global packet switch network, wherein said call management information is directed to said home intelligent gateway by said home mobile network. Kari also suggests wherein the BGGSN may be connected via an intelligent network to the billing center (col. 6,lines 17-28).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Kirby to include implementation of GPRS communication in a GSM or

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similar mobile communication system for the purpose of providing an intelligent gateway integrated into a GPRS system, which provides prepaid account or debit services.

6. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kirby and Kari, in view of Dahm et al. ("Dahm"), U.S. Patent No. 6,466,783.

Regarding claims 8 and 10, the combination of Kirby and Kari disclose the method of claims 7 and 9, respectively. The combination fails to explicitly disclose the method comprising the steps of: enabling said user to recharge said balance during a mobile originated (or terminated) call; and enabling said user to continue said mobile originated (or terminated) call if said balance has been sufficiently recharged.

In a similar field of endeavor, Dahm suggests a visual interface for mobile subscribers wherein a customer service menu is available for recharging prepaid services (col. 10, lines 6-13).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination of Kirby and Kari to include enabling said user to recharge said balance during a mobile originated (or terminated) call; and enabling said user to continue said mobile originated (or terminated) call if said balance has been sufficiently recharged for the purpose allowing the user continue conversation upon exhaustion of prepaid balance (see Kirby, col. 1, lines 43-45).

Allowable Subject Matter

7. Claims 1-5 and 12-19 are allowed.

Conclusion

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

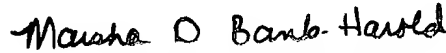
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

September 20, 2004


MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600